

REMARKS

Claims 1 to 20 are pending. Claims 1, 10 and 20 are currently amended. Reconsideration of the application is requested.

Election/Restriction

The claims 1-20 were restricted to the invention of claims 1-19 and the invention of claim 20. Applicant elected to prosecute claims 1-19. Even though it was not elected, claim 20 has been amended so as to be dependent on claim 1. Therefore, while claim 20 will not be examined, at the end of the prosecution of this case, when claim 1 is found to be patentable, claim 20 will not need to be cancelled.

§ 102 Rejections

Claims 1-2, 5-10 and 14-19 are rejected under 35 USC § 102(b) as being anticipated by Langer et al. (U.S. Patent No. 6,458,418 B2). In support of this rejection, the Office Action states:

Regarding Claim 1, Langer et al. reference teaches a multilayer mat comprising: a first intumescent layer, a non-intumescent layer, said non-intumescent layer comprising inorganic fibers (See Column 10, Line 1-6), and a second intumescent layer in the respective order (See Column 15, Line 60-64 – Three layer mat with adjacent layers having different compositions). The multilayer Mat of Langer et al. is structurally **capable** of performing the claimed intended use. (emphasis added)

The Office Action appears to take the position, based on the above statement, that the present claims 1-2, 5-10 and 14-19 are anticipated because the Langer et al. invention could be used to make the present claimed multilayer mat. However, whether the Langer et al. invention is capable of being used to produce the present claimed invention is not dispositive to the issue of anticipation. It is well settled that anticipation under 35 U.S.C. §102 requires that each and every element of the claimed invention be found in a single prior art reference. See for example, Lindeman Maschinenfabrik GmbH v. American Hoist and Derrick Company, 221 USPQ 481, 485 (CAFC 1984).

Langer et al. is directed to a method of forming a multilayer sheet that is suitable for use as a mounting mat or a firestop. It is respectfully submitted that Langer et al. does not disclose, teach or suggest a multilayer mat having a non-intumescent layer positioned between two intumescent

layers, where the two intumescent layers form the outer layers of the multilayer mat. The above noted passages from Langer et al., cited in the Office Action, do not provide such disclosure, teaching or suggestion. For example, the passage in Langer et al. on column 10, lines 1-6 expressly states:

Generally, the non-moldable flexible non-intumescent layers may contain at least one of inorganic fibers, organic binder, filler materials, organic fiber or may contain any combination thereof. Useful non-intumescent layers include combinations of inorganic fiber and organic binder, and organic binder and organic fiber.

This passage teaches what a non-intumescent layer may contain. It teaches nothing about an intumescent layer. In addition, the other passage in Langer et al., on column 15, lines 60-64, expressly states:

The present invention also contemplates intumescent sheets having three or more layers wherein at least one layer comprises an intumescent material and wherein adjacent layers are desirably comprised of different compositions.

This passage teaches that intumescent sheets made according to the Langer et al. invention (1) can have three or more layers, (2) at least one of these layers can comprise an intumescent material and (3) the layers can comprise different compositions. It should be noted that there are many different intumescent, as well as non-intumescent, material compositions available in the prior art. This passage provides no guidance on what layers a Langer et al. multilayer sheet contains beyond having an intumescent layer and a non-intumescent layer.

It is clear from the above cited passages that Langer et al. does not expressly disclose a multilayer mat having a non-intumescent layer positioned between two intumescent layers, where the two intumescent layers form the outer layers of the multilayer mat. As such, Langer et al. does not disclose each and every element of the claimed invention and, therefore, cannot anticipate claims 1, 2, 5-10 and 14-19. Accordingly, it is submitted that the Office Action has failed to meet the USPTO's burden of proving a prima facie case of anticipation and, as a result, this rejection of claims 1, 2, 5-10 and 14-19 under 35 USC § 102(b) should be withdrawn.

Because it is believed that there may have been a problem with interpreting the language of original independent claims 1 and 10, these two claims have been amended in an effort to more clearly recite that the non-intumescent layer is positioned between the two intumescent layers. It is submitted that this amendment was not necessary in order to overcome this rejection.

Consequently, any final rejection made in a second patent office action would be premature and improper. See MPEP §§706.07(a), (c) and (d).

§ 103 Rejections

Claims 3-4 and 12-13 are rejected under 35 USC § 103(a) as being unpatentable over Langer et al. (US Patent No. 6,458,418 B2) in view of Merry (US Patent No. 4,929,429).

As noted above, Langer et al. does not anticipate the independent claims 1 and 10. It is also submitted that Merry does not provide a disclosure that cures the deficiencies of Langer et al, and the Office Action fails to provide any evidence to the contrary. Therefore, it is submitted that the combination of Langer et al. and Merry does not disclose, teach or suggest the invention recited in claims 3, 4, 12 or 13. Accordingly, this rejection of claims 3, 4, 12 and 13 under 35 USC § 103(a) should be withdrawn.

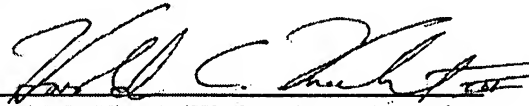
Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Examination and reconsideration of the application is requested.

Respectfully submitted,

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Date

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